UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,398	12/05/2003	William M. Brandt	14012-071001/70-03-007	8841

26230   7590   11/14/2007

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER
GERGISO, TECHANE

ART UNIT	PAPER NUMBER
2137	

MAIL DATE	DELIVERY MODE
11/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/729,398	BRANDT, WILLIAM M.
Office Action Summary	Examiner	Art Unit	
	Techane J. Gergiso $\;$ $\mathcal{J}$-$\mathcal{G}$	2137	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _16 July 2007_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

J

DETAILED ACTION

1.   This is a non-final Office Action in response to the applicant's communication filed on

July 16, 2007.

2.   Claims 1-20 have been examined are pending.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Although the claims are identified as "System",

the components of the "system" are instructions executed by a computer and are thus considered

programs per se (They are, at best, a functional descriptive material per se). As such they fail to

fall within in a statutory category. *See MPEP 2106 (IV)(B)(1) Functional descriptive Matter.*

Response to Arguments

5.   Applicant's arguments with respect to claims 1-20 have been considered but are moot in

view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Engberg (US

Pub No.: 2003/018960 A1).

As per claim 1:

Engberg discloses a method for preventing identity theft in electronic communications,

comprising the steps of:

sequencing an encryption key transaction from a trusted service for generating for an individual a

consumer identifier by performing the steps of:

([0260] A Virtual Identity is a pseudonym for an individual created for a specific

purpose. Using the Trusted Party (TP), an individual can assume use a VID to

communicate, trade etc. anonymously and under full control of the process. [0265] TP--

Trusted Party--is generally treated as one entity identified by a TP Token Identifier or the

public key of TP (TP.Pu) that can be verified in official registers such as X500 or X509.

[0366] Establish a CLIENTKey which is a general symmetric encryption key between TP

and CLIENT. [0401] Secret key of VID (Cl.Vir.Pr) is known only to TP, as TP is backing

the authenticity of VID to CLIENT.)

issuing to the individual a unique identifier from said trusted service; and

   ([0391] Establish VID (CLIENT/COMPANY). [0395] CLIENT establishes an anonymous

   identity towards a relation under full CLIENT control. [0401] Secret key of VID

   (Cl.Vir.Pr) is known only to TP, as TP is backing the authenticity of VID to CLIENT.)

permitting the individual to generate and maintain a consumer-defined sequence through said

   trusted service; and

   ([0404] This invention works with a secret shared symmetric key SYMKEY to encrypt

   communication between CLIENT and COMPANY. In the following the SYMKEY is

   treated as if it is reused from session to session; however the SYMKEY can just as well be

   generated as part of establishing a session as a session specific encryption key which is

   saved together with communication encrypted by the public key of CLIENT (Cl.Pu).

   [0405] SYMKEY can be created without revealing this to TP.)

allowing the individual to control access to commercially related use of said consumer identifier

   by third parties .

   ([0475] When creating a virtual identity on behalf of CLIENT, TP creates a new set of

   signature keys (Cl.Vir.Pr and Cl.Vir.Pu). TP keeps the private key Cl.Vir.Pr which is not

   revealed to anyone else.)

As per claim 2:

   Engberg discloses a method, comprising the steps of verifying commercially related use

of said consumer identifier, comprising the steps of:

initiating a verification process from a requesting business entity via a secure connection

(0737; 0743);

comparing said consumer identifier with a pre-determined set of database records using

said consumer-defined sequence in response to initiating said verification process

(0489);

presenting a positive or negative confirmation to said requesting business, said business

having registered with said trusted service (0491); and

confirming requested information relating to the individual via said secure connection,

said requested information have been pre-authorized for presenting to said

requesting business entity by the individual (0490).

As per claims 3 and 12:

Engberg discloses a method and instructions stored on a computer–readable medium,

comprising the step of reporting to the individual the number of times at least one requesting

business entity has initiated a verification process (0949-0952).

As per claim 4:

Engberg discloses a method and instructions stored on a computer–readable medium,

comprising the step of confirming requested information relating to the individual including the

individual's name, address, and photograph (90279; 0341-0342).

As per claim 5:

Engberg discloses a method and instructions stored on a computer–readable medium, comprising the step of confirming requested information relating to the individual including the individual's fingerprints (0338-0039; 0453).

As per claim 6:

Engberg discloses a method and instructions stored on a computer–readable medium, comprising the steps of storing said consumer identifier on a remote business database system and permitting the individual to modify said consumer identifier through a secure connection to a remote location (0694-0696).

As per claim 7:

Engberg discloses a method and instructions stored on a computer–readable medium, comprising the step of issuing to the individual a unique identifier from said trusted service according to a pre-determined set of business rules associated with a remote business database system (0270).

As per claim 8:

Engberg discloses a method and instructions stored on a computer–readable medium, comprising the step of allowing the individual to control commercial transactions using said consumer identifier (0552-0556).

As per claim 9:

Engberg discloses a method and instructions stored on a computer–readable medium, comprising the step of issuing to the individual a unique identifier from said trusted service, said unique identifier conveying in encrypted information relating to the individual's age and locale (0881; 0888).

Claims 10 and 11 are a system comprising instruction stored on a computer-readable medium for performing the steps of claims 1 and 2 respectively. Claims 10 and 11 are substantially similar to their corresponding method claims 1 and 2; and therefore, they are rejected with the same rationale given to reject claims 1 and 2 respectively.

Claims 19 and 20 are a computer readable storage medium comprising instruction stored on a computer-readable medium for performing the steps of claims 1 and 2 respectively. Claims 19 and 20 are substantially similar to their corresponding method claims 1 and 2; and therefore, they are rejected with the same rationale given to reject claims 1 and 2 respectively.

Conclusion

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

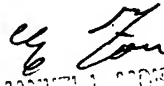See the notice of reference cited in form PTO-892 for additional prior art.

Contact Information

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T.G./

November 12, 2007

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER